Doc Code: AP.PRE.REQ

PTO/SB/33 (12-08)
Approved for use through 01/31/2009. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
ITL.0482US (P10030)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on June 10, 2009

Signature /Cynthia L. Hayden/

Typed or printed name Cynthia L. Hayden

Application Number	Filed
09/690,512	October 17, 2000
First Named Inventor	
Eric C. Hannah	
Art Unit	**Examiner**
3688	Jean D. Janvier

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [ ] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [x] attorney or agent of record. Registration number 28,994
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

/Timothy N. Trop/
Signature

Timothy N. Trop
Typed or printed name

(713) 468-8880
Telephone number

June 10, 2009
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [ ] *Total of _ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Eric C. Hannah et al.	§	Group Art Unit:	3688
Serial No.:	09/690,512	§	Examiner:	Jean D. Janvier
Filed:	October 17, 2000	§	Attorney Docket.:	ITL.0482US P10030
For:	Ensuring that Advertisements are Played	§	Conf. No.:	3230

Mail Stop **AF**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Section 101

Reconsideration of the rejection of claim 29, based on Section 101, is requested because the rejection is barred *res judicata*. This exact same rejection has already been reversed by the Board of Appeals and that decision is now final. That decision is *res judicata* at this point and further re-raising is inappropriate.

Moreover, the M.P.E.P. does not authorize re-raising non-prior art issues after one, much less two, reversals by the Board of Appeals. M.P.E.P. § 1214.04. The only basis for raising new rejections is finding a new reference. No new reference was found with respect to the Section 101 rejection and it is improper for this additional reason.

Finally, there is absolutely no law which in any way supports the test asserted in the office action. See *Ex parte* BO LI, Appeal 2008-1213, decided Nov. 6, 2008 at p. 7.

> Therefore we also conclude that the "useful, concrete and tangible result" inquiry is inadequate and reaffirm that the machine-or-transformation test outlined by the Supreme Court

Date of Deposit: June 10, 2009
I hereby certify that this correspondence is being electronically transmitted on the date indicated above.
Cynthia L. Hayden
Cynthia L. Hayden

> the proper test to apply." [Footnote: As a result, those portions of our opinions in State Street and AT&T relying solely on a "useful, concrete and tangible result" analysis should no longer be relied on. *In re Bilski*, Case 2007-1130, page 20, (Fed. Cir., Oct. 30, 2008).

Claim 21

Likewise, the rejection of claims 21 *et seq.* over the exact same art, which has already been examined by the Board, is improper. There is no authority for reopening prosecution as to a claim over art that has already been considered. The only basis for reopening prosecution is finding a new reference. See M.P.E.P. § 1214.04. Therefore, it is respectfully requested that the rejection be withdrawn and, if not, that the undersigned be notified so that an appropriate petition can be filed.

Furthermore, it is noted that the cited reference is completely inapplicable, as already found by the Board.

Finding of fact 8 of the Board in the last reversal is as follows:

> "Further, although Rodriguez discloses a watermark detector to detect a watermark included with an advertisement, it does not disclose that the watermark detector controls operation of a media player in response to detection of the watermark."

The assertions from the office action in connection with the rejection, which are extensive and are very difficult to follow, appear to be directly contrary to the Board's existing finding. See, e.g. page 16.

That Board decision is now final and, thus, principles of *res judicata* apply as well.

Paragraph 9 of the Board's decision states as follows:

> "Rather, Rodriguez appears to disclose that the watermark detector detects a watermark included with an advertisement and then passively monitors whether the recipient views the advertisement in its entirety. If the advertisement is viewed in its entirety, the watermark detector issues a receipt. (Rodriguez, col. 58, ll. 11-13)."

Again, the Examiner's findings are directly contrary. A single reference 103 rejection, based on a reference that the Board has already found does not show the claimed invention, simply does not make out a *prima facie* rejection. There is no basis within the reference itself

to modify the reference that teach the very thing the Board said it does not teach or else the Board would have so found. Thus, the rejection is not only untenable, but directly contrary to the Board's decision. As a result, the rejection violates the principles set forth in the M.P.E.P. § 1214. 04 for reopening prosecution, is contrary to principles of *res judicata*, and is, therefore, improper.

Respectfully submitted,

Date: June 10, 2009

Timothy N. Trop, Reg. No. 28,994
Trop, Pruner & Hu, P.C.
1616 South Voss Road, Suite 750
Houston, Texas 77057-2631
(713) 468-8880 [Phone]
(713) 468-8883 [Fax]

Attorneys for Intel Corporation